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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s): T. FUJIWARA et al.

Serial No.: 08/926,008

Filed: September 9, 1997

For: **INFORMATION DISPLAY SYSTEM FOR DISPLAYING
SPECIFIED LOCATION WITH MAP THEREAROUND ON
DISPLAY EQUIPMENT**

Art Unit: 2632

Examiner: B. Swarthout

**PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 C.F.R. §1.144 AND FROM
A PREMATURE FINAL OFFICE ACTION
UNDER 37 C.F.R. §1.181**

Assistant Commissioner for Patents
Washington, D.C. 20231

June 4, 2002

Sir:

Applicants hereby respectfully petition from the improper constructive election and withdrawal of claims 53-59 from consideration as being directed to an allegedly non-elected invention under M.P.E.P. §821.03, and the premature designation of Paper No. 29 as "final" Office action, request withdrawal of the designation of "final", for complete Office Action and restarting of period for response, and as reasons therefore, state that:

A

STATEMENT OF FACTS

1. On April 11, 2000, Applicants filed a request for Continued Prosecution Application (CPA) under 37 C.F.R. §1.53(d) based on parent Application No. 08/926,008 in which claims 1-52 were presented for prosecution.
2. On February 2, 2001, the Examiner issued a Restriction Requirement (Paper No. 22) in which alleged different combination-subcombination inventions were separated into: Group I (claims 1-4 and 49-52) drawn to a display system for displaying icons based on shape data, classified in Class 340, subclass 995; Group II (claims 5-21 and 29-46) drawn to a display system with retrieval range setting and icon setting and outside data reception, classified in Class 340, subclass 995; Group III (claims 22-28) drawn to a display device for data from network servers, classified in Class 395, subclass 200.5; and Group IV (claims 47-48) drawn to a display system for displaying facilities on a map, classified in class 340, subclass 995.
3. On February 28, 2001, Applicants filed a Response to the Restriction Requirement in which the invention of Group I directed to claims 1-4 and 29-52 was elected, with traverse.
4. On May 22, 2001, the Examiner issued a premature, and incorrect final Office action (Paper No. 24) in which the rejections were formulated for another patent application.
5. On June 4, 2001, Applicants submitted a Request, via a telephone conference, to request the Examiner to issue a correct Office action.
6. On June 14, 2001, the Examiner issued a first Office action (Paper No. 25) in which the Restriction Requirement was made FINAL, and claims 5-48 were constructively withdrawn. The Examiner also constructively canceled claims 1-4, and rejected claims 49-52 under 35 U.S.C. §103(a) as being unpatentable over Prabhakaran, US. Patent No. 5,904,727.

7. On December 13, 2001, Applicants traversed the rejection of claims 49-52 under 35 U.S.C. §103(a) and pointed out to the Examiner that the rejection was improper because Prabhakaran '727 does **not** disclose "any displayed icon that is based on icon image data offered by facilities received from an information offering equipment (server), and that the icon image data included in the icon image information to be displayed is transmitted from the information offering equipment (server)" as defined by Applicants' independent claim 49, and any "position information of a map icon which is retrieved according to said retrieval condition by said information offering equipment and is transmitted from said information offering equipment" as defined by Applicants' independent claim 50. In addition, Applicants reworded couple phrases in claims 49 and 50 for purposes of clarity and brevity, and added claims 53-59 to alternatively define the elected invention in terms of the distinguishing features of claims 49 and 50.
8. On March 5, 2002, the Examiner issued another premature final Office action (Paper No. 29) rejecting claims 49-52 under 35 U.S.C. §103(a) as being unpatentable **over newly cited art**, Behr et al., U.S. Patent No. 5,543,789 as modified to incorporate selected features from Sato, U.S. Patent No. 6,009,403. The Examiner also improperly ignored examining previously added claims 53-59 and constructively canceled claims 53-59 by simply alleging that claims 53-59 are directed to an invention that is independent or distinct from claims 49-53.

REMARKS

First of all, M.P.E.P. §707.07(a) defines a **premature** final Office action as one:

"where the examiner introduces a new ground of rejection **not** necessitated by amendment of the application by applicant".